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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/646,626	09/20/2000	Dieter Bauerfeind	10677/31	5098

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EXAMINER	
BECKER, SHAWN M	

ART UNIT	PAPER NUMBER
2173	

DATE MAILED: 09/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/646,626	BAUERFEIND, DIETER	
	Examiner	Art Unit	
	Shawn M. Becker	2173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 July 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *10 and 13-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *10 and 13-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This action is in response to the Request for Continued Examination, filed 7/19/2004.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 10, 13-17, and 19-22 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,877,957 to Bennett (hereinafter Bennett).

3. Referring to claims 10, 20, and 21, Bennett teaches a programmable controller (col. 3, line 33) comprising a processing unit/means (Fig. 2, CPU 26) programmed to affect a switching sequence between, one of at least one input signal and at least one simulated input signal, and at least one output signal (i.e. col. 2, lines 16-24), a display screen/means including a menu-assisted user interface (Fig. 19 and col. 15, lines 18-22), an operator unit including a button, the button capable of being switched to an active mode using a programmable function (see col. 15, line 65 - col. 16, line 34 which describes activating one of the keypad buttons to be a trigger event for switching the mode of a device after selecting the "Training" button) at least one signal input terminal configured to receive the at least one input signal (i.e. link that receives trigger event; col. 2, line 39), at least one signal output terminal (i.e. link that broadcasted control signal; see col. 3, lines 47-57) and a housing unit in which the processing unit, the display screen, the

operator unit, the at least one signal input terminal, and at least one signal output terminal are disposed. See col. 15, lines 18-65 and Fig. 19.

Bennett discloses a switching function of the controller programmable in the programmed switching sequence according to predetermined functions using the menu-assisted user interface, and wherein an operation of the button in the active mode is configured to generate the at least one simulated input signal and to affect the switching sequence of the switching function between the at least one simulated input signal and the at least one output signal. See col. 8, lines 7-10, which describes mimicking (simulating) an input signal and col. 15, line 65 - col. 16, line 34, which describes how selection of the keypad button that is the trigger event switches at least one of the devices in the house and using a button on the programmable controller as the trigger event to turn on a lamp instead of the turning on of a different lamp as in Fig. 10, for example. Therefore, pressing the button simulates the input signal of turning on a lamp and affects the switching function (i.e. turns on another lamp).

Referring to claim 13, the switching function of Bennett is interrupted when the button (trigger event) is operated in the active mode. See col. 2, lines 26-47.

Referring to claim 14, the operation of the button of Bennett is performable at any point of the programmable switching function. See col. 16, lines 36-43, which shows a menu option for allowing the switch to occur at all times.

Referring to claim 15-16, Bennett shows a second button capable of affecting the switching function and capable of being switched to an active mode. See the plurality of buttons on the keypad in Fig. 19 and col. 15, line 65 - col. 16, line 34.

Referring to claim 17, the display screen of Bennett is capable of displaying an instruction to operate the active button. See Fig. 19, and example instructions at col. 16, lines 25-30.

Referring to claim 19, the switching function of Bennett is arranged to switch between input voltages applied to the at least one signal input terminal and the at least one signal output terminal. For example, see col. 5, lines 10-34 and 49-62, which describe an input trigger event, which may be a device turning on (requiring voltage), that causes a device (i.e. lamp) to turn on (output voltage).

Referring to claim 22, Bennett discloses a method for directing current by a programmable controller including a processing unit (Fig. 2, CPU 26), a display screen (Fig. 19), at least one signal input terminal (i.e. link that receives trigger event; col. 2, line 39), at least one signal output terminal (i.e. link that broadcasted control signal; see col. 3, lines 47-57), a common housing, the processing unit, the display screen, the signal input terminal, and the signal output terminal accommodated in a common housing (col. 15, lines 18-65 and Fig. 19), and an arrangement configured to program switching functions on the basis of a predetermined function in accordance with a menu-assisted user interface on the display screen, a sequence of a switching function dependant on operation of a button. See col. 15, line 65 - col. 16, line 34, which describes how selection of the keypad button that is the trigger event switches at least one of the devices in the house.

Bennett enters a program into the process into the processing unit including switching functions configured to control current flow between the at least one input terminal and the at least one output terminal (col. 2, lines 29-47 and col. 7, lines 54-58).

Bennett discloses operating the button in an active mode so as to generate at least one simulated input signal and so as to affect the switching sequence of the switching function between the at least one simulated input signal and the at least one output signal. See col. 8, lines 7-10, which describes mimicking (simulating) an input signal and col. 15, line 65 - col. 16, line 34, which describes how selection of the keypad button that is the trigger event switches at least one of the devices in the house and using a button on the programmable controller as the trigger event to turn on a lamp instead of the turning on of a different lamp as in Fig. 10, for example. Therefore, pressing the button simulates the input signal of turning on a lamp and affects the switching function (i.e. turns on another lamp).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett and U.S. Patent No. 5,997,167 to Crater et al. (hereinafter Crater).

The display screen of Bennett is capable of displaying an instruction to operate the active button. See Fig. 19, and example instructions at col. 16, lines 25-30. Bennett also shows a speaker in Fig. 19, but does not explicitly state that the instruction to operate the active button is accompanied by an acoustic signal. However, Crater discloses a programmable controller with diagnostic and simulation facilities that plays an audible alarm (acoustic signal) along with

directions on the display. See col. 6, lines 39-44. It would have been obvious to one of ordinary skill in the art to use the speaker of Bennett to play an acoustic signal that accompanies the display of an instruction to operate the active button in order to capture the operator's attention as supported in Crater.

Response to Arguments

6. Applicant's arguments filed 7/19/2004 have been fully considered but they are not persuasive.

Applicant requests a copy of the dictionary relied upon for the definition of "terminal". The requested copy is submitted herewith.

7. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., separate input and output terminals and a preexisting controller switching program) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claims do not explicitly state that the input and output terminal must be separate terminals; rather, the claims state that there is an input terminal and an output terminal. Furthermore, Bennett discloses input signals and output signals wherein the connections may be over dedicated wiring, which inherently is linked to terminals. See col. 6, lines 22-27. The claims also do not state the controller switching program needs to be preexisting. Notwithstanding, clearly the training in Bennett may be done multiple times, thus affecting/changing a switching function. See col. 2, lines 25-47.

Applicant argues that Bennett does not disclose a button in the active mode that is usable to generate a simulated input signal and affect the switching sequence of the switching function. However, col. 8, lines 7-10, describes mimicking (simulating) an input signal and col. 15, line 65 - col. 16, line 34 describes how selection of the keypad button that is the trigger event switches at least one of the devices in the house. Bennett describes using a button on the programmable controller as the trigger event to turn on a lamp instead of the turning on of a different lamp as in Fig. 10, for example. Therefore, pressing the button simulates the input signal of turning on a lamp and affects the switching sequence of the switching function between the simulated input signal and the output signal (i.e. turns on another lamp).

Applicant argues with respect to claim 13 that the "training" mode does not interrupt the switching function; however, placing the system in "training mode" pauses/interrupts the switching functions already in place and activated.

8. Applicant's arguments with respect to claims 14-19 fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawn M. Becker whose telephone number is (703) 305-7756. The examiner can normally be reached on M-F 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Cabeca can be reached on (703) 308-3116. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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